

REMARKS

Claims 1-28 are pending in the present Application. Claims 5, 6, and 20 have been canceled, Claims 1, 7, 11, 18 and 24, have been amended, and no claims have been added, leaving Claims 1-4, 7-19, and 21-28 for consideration upon entry of the present Amendment.

Claims 1, 18, and 24 have each been amended to include the limitations of Claims 5 and 6, canceled herewith. Claim 7 has been amended to correctly depend from Claim 1. Claim 11 has been amended to correct an inadvertent grammatical error, and to have proper antecedent basis in Claim 1. No new matter has been introduced by these amendments.

Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Claim Rejections Under 35 U.S.C. § 102(b)

Claims 1-4, 16-17 and 27 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent No. 6,726,995 (“Ishii”). As the Examiner has based the rejections over Ishii on the U.S. Patent, rather than to the corresponding International Patent Application WO 2001/48519, all discussion of Ishii in this Response will be with regard to the corresponding US Patent. Applicants respectfully traverse this rejection.

To anticipate a claim, a reference must disclose each and every element of the claim. *Lewmar Marine v. Varient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987).

Claim 1 has been amended to include the limitations of Claims 5 and 6 (canceled herewith), neither of which has been rejected by the Examiner as anticipated under 102(b) by Ishii. Accordingly, Claim 1 and its dependents 2-4, 16-17 and 27, which include all the limitations of Claims 5 and 6 are not anticipated by Ishii. Reconsideration and allowance are respectfully requested.

Claims 1, 3-4, 6-9, and 13-15 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent Application Publication No. 2003/0119961 (“Oshima”). Applicants respectfully traverse this rejection.

Claim 1 has been amended to include the limitations of Claims 5 (canceled herewith), which was rejected by the Examiner as inherent to the composition of Claim 1, and hence is anticipated. Claim 6 has been canceled as described above.

The Examiner has stated that the retardation value of 60-1,000 nm (measured at a wavelength of 550 nm when the film thickness is set to 30-200 μm) in Claim 1 (which includes the limitations of Claim 5) would be inherent in view of Oshima. See Office Action dated 10/16/07, p. 4, section 12. Oshima discloses preparation of a retardation film with a thickness of 80 μm , having a retardation value of 136 μm (which is significantly larger than the maximum claimed value of 1,000 nm in instant Claim 1) when measured at a wavelength of 633 nm (note that Oshima does not disclose specifically whether the retardation value is measured in plane or for thickness). Oshima, p. 20, ¶ [0405]. In order to support an anticipation rejection based on inherency, an Examiner must provide factual and technical grounds establishing that the inherent feature necessarily flows from the teachings of the prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int. 1990); *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (holding that inherency must flow as a necessary conclusion from the prior art, not simply a possible one). One skilled in the art will appreciate that the retardation values disclosed in Oshima and claimed in instant Claim 1 are not identical values, and that the values disclosed in Oshima cannot anticipate those claimed in instant Claim 1. One skilled in the art will further appreciate that the refractive index can vary with wavelength depending on the composition of the material being tested, though assuming for the sake of argument that the refractive indices were comparable at a wavelength 633 nm disclosed by Oshima and at a wavelength of 550 nm as claimed in instant Claim 1, the retardation values are still not identical, and there would be no reason to expect the retardation value of Oshima to fall within the claimed range of instant Claim 1.

Oshima therefore apparently discloses a film with a retardation value greater than that claimed in instant Claim 1, and in any event, Oshima fails to disclose these limitations of Claim 1. As mentioned hereinabove, one skilled in the art will appreciate that refractive indices of polymer films will vary with polymer composition, and that different cycloolefin monomers having different functional groups will have different refractive indices. When viewed in this way, the requirement for retardation value falling within a particular range should be viewed as a further compositional limitation for the cycloolefin polymer claimed in Claim 1. Oshima specifies that the cycloolefin polymers disclosed therein have both a reactive silylated monomer (for crosslinking purposes; of formula 1) and a second monomer

(of formula 2). See Oshima, p. 4, ¶¶[0044]-[0051] and [0058]. There is neither a requirement of crosslinking in the composition of the instant claims, nor is there a requirement of the silylated monomers disclosed in Oshima. Therefore, for at least these reasons, the limitations of Claim 5, now incorporated into Claim 1, are not inherent to the cycloolefin polymer of Claim 1.

Accordingly, Claim 1 and its dependents 3-4, 7-9 and 13-15, which include all the limitations of Claim 5 are not anticipated by Ishii. Reconsideration and allowance are respectfully requested.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 10-12 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Oshima. Applicants respectfully traverse this rejection.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, or knowledge generally available in the art at the time of the invention, must provide some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The obviousness inquiry also requires consideration of common knowledge and common sense. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742-43 (2007); *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006) (“Our suggestion test is in actuality quite flexible and not only permits, but requires, consideration of common knowledge and common sense.”)

Oshima discloses an optically transparent material comprising a cyclic olefin addition copolymer containing reactive silyl group and a cross-linking catalyst (at least one compound selected from compounds 1), 2), 3), and 4) of Oshima. See Oshima, p. 12, ¶ [0264], and Claim 7. The cross-linking catalyst (comprising compound 1), 2), 3), or 4)) of Oshima catalyzes the reaction of the polymers having reactive silyl groups to form siloxane bonds, by which the cyclic olefin addition copolymer cross-links. Oshima, p. 4, ¶¶ [0044] and [0264].

However, as disclosed in the instant specification, the transparent film according to the present invention does not comprise the cross-linking catalyst. In addition, the cyclic olefin-based addition polymer in the transparent film according to the subject invention is not cross-linked.

Further Oshima discloses that the optically transparent materials can be used as a retardation film. However, the retardation film of the reference by Oshima is produced by subjecting the film to a stretching-orientation treatment. See Oshima, p. 12, ¶ [0405]. Also, the reference by Oshima does not disclose the concrete optical property such as the retardation value along the film thickness direction (R_{th}).

In contrast, the transparent film according to the present invention does not require a stretching-orientation treatment, and has a specific retardation value (R_{th}) along the film thickness direction.

Oshima therefore fails to teach or disclose all elements of the instant claims, and provides no teaching or incentive that would lead one skilled in the art to use the composition of Oshima in a retardation film having the properties of that claimed in Claim 1, absent crosslinking of the polymer. Further, as Oshima fails to disclose a film thickness retardation value, there would be no reasonable expectation that use of the composition of Oshima would be successful when applied to the retardation film as disclosed in the instant specification and claimed in the instant Claims. Ishii therefore fails to make Claims 10-12 unpatentable. Reconsideration and allowance are therefore respectfully requested.

Claims 24-26 and 28 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Ishii. Applicants respectfully traverse this rejection.

As claimed, the protection layer of a transparent film of instant Claim 1 comprises a cyclic olefin-based addition polymer of the compound represented by Chemical Formula 1. The transparent film has a specific retardation value (R_{th}) along the film thickness direction, of 60-1,000 nm measured at a wavelength of 550 nm for a film of 30 to 200 μm thick. Thus, the transparent film can be used as an optical compensation film of LCD (Liquid Crystal Display) as well as a protection film of a polarizing film. That is, an LCD comprising the

polarizing plate according to the invention does not require an additional optical compensation film.

Ishii does not disclose a retardation value (R_{th}) along the film thickness direction. The reference by Ishii discloses only an in-plane retardation value (R_0 or R), and thus does not disclose an optical property such as retardation value along the film thickness direction. In addition, the protective film according to the reference by Ishii cannot be used as an optical compensation film, due to its low in-plane retardation value of 0.2 nm See Ishii, Col. 10, line 37 in Table 1.

Ishii therefore fails to teach or disclose all elements of the instant claims, and provides no teaching or incentive that would lead one skilled in the art to use the composition of Ishii in an optical compensation film. Further, as the in-plane retardation value is low, there would be no reasonable expectation that use of the composition of Ishii would be successful when applied to the optical compensation film as disclosed in the instant specification. Ishii therefore fails to make the instant Claims 24-26 and 28 unpatentable. Reconsideration and allowance are therefore respectfully requested.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,
CANTOR COLBURN LLP

By: /Dana A. Gronbeck/
Dana A. Gronbeck
Reg. No. 55,226
Confirmation No. 6242
CANTOR COLBURN LLP
20 Church Street
22nd Floor
Hartford, CT 06103
Telephone: 860-286-2929
Fax: (860) 286-0115
PTO Customer No. 23413

Date: January 16, 2008